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09/862,825	05/22/2001	Satoru Ueda	7217/64562	8871

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EXAMINER

YIGDALL, MICHAEL J

ART UNIT PAPER NUMBER

2122

DATE MAILED: 08/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/862,825

Applicant(s)

UEDA, SATORU

Examiner

Michael J. Yigdall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2001, 18 Mar. 2003, 28 Mar. 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-9 have been examined. The priority date considered for this application is 25 May 2000.

***Specification***

2. The disclosure is objected to because of the following informalities: the claim for foreign priority under 35 U.S.C. 119 should be the first item noted in the specification.

Appropriate correction is required.

3. The abstract of the disclosure is objected to because it must not exceed 150 words. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/14085 to Reeder.

With respect to claim 1, Reeder discloses a software program providing system for providing and managing access to a software program (see page 3, lines 11-15), comprising:

(a) a storage medium for storing said software program and an individual identification code (see page 5, lines 10-14, which shows the storing of a software program and an identification code in a permanent store);

(b) a user terminal for installing said storage medium and for accessing said software program (see page 3, lines 32-37, and page 4, lines 1-6, which describe a user apparatus and its permanent store);

(c) database management means for storing individual information of a user, information regarding a range of access limitation to said software program, and information regarding a condition of access to said software program, based on said individual identification code as a search key (see page 6, lines 28-30 and 37, and page 7, lines 1-5, which show the searching of records stored in a database for software usage rights, based on the identity of a user apparatus and an individual code word); and

(d) information communication means for connecting said database management means with said user terminal (see page 3, lines 21-31), wherein

said software program providing system authorizes said user terminal to access said software program based on said information regarding said range of access limitation and said information regarding said condition of access to said software program and said information search by said individual identification code as a search key, said database management means reading said individual identification code from said storage medium installed in said user terminal, through said information communication means (see page 11, lines 20-29).

With respect to claim 2, Reeder discloses the software program providing system according to claim 1, wherein said database management means further comprises fee charging

means for charging a fee according to said condition of access to said software program (see page 7, lines 22-29, which describes how software usage charges are recorded).

With respect to claim 3, Reeder discloses the software program providing system according to claim 1, wherein said information communication means further comprises ciphering means for ciphering communication between said database and said user terminal (see page 7, lines 5-9).

With respect to claim 5, Reeder discloses a software program providing method for providing and managing access to a software program (see claim 1 above), comprising the following steps of:

(a) storing said software program along with an individual identification code (see part (a) of claim 1 above);

(b) storing into a database, information regarding individual information of a user, information regarding a range of access limitation to said software program, and information regarding a condition of access to said software program (see part (c) of claim 1 above);

(c) communicating between a user terminal having said storage medium installed thereon and a database management means managing said database (see part (d) of claim 1 above),

wherein said communicating is done when said user accesses said software program stored in said storage medium (see page 4, lines 32-36, which shows the initiating of a transmission based on a user action); and

(d) authorizing said user terminal to access said software program, when said access is limited to a range of access limitation, based on said information regarding said range of access limitation go said software program and said information regarding said access condition to said

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software program, and said information search from said database based on said individual identification code, wherein said individual identification code is read out from said storage means (see part (d) of claim 1 above).

With respect to claim 6, Reeder discloses the software program providing method according to claim 5, wherein

said process of providing authorization for accessing said software program further comprises the step of charging a fee according to said condition of access to said software program (see claim 2 above; also see page 9, lines 25-27).

With respect to claim 7, Reeder discloses the software program providing method according to claim 5, wherein said communicating step further comprises the step of ciphering communication between said user terminal and said database management means (see claim 3 above).

With respect to claim 8, Reeder discloses a software program providing system for managing access to a software program (see claim 1 above) comprising:

(a) database management means for storing individual information of a user, information regarding a range of access limitation to said software program, and information regarding a condition of access to said software program, based on an individual identification code as a search key (see part (c) of claim 1 above), wherein

said software program providing system authorizes a user terminal to access said software program, based on said information regarding said range of access limitation and said information regarding said condition of access to said software program, and said information searched by said individual identification code as a search key (see part (d) of claim 1 above).

With respect to claim 9, Reeder discloses the software program providing system according to claim 8, wherein said database management means reads said individual identification code from a storage medium installed in said user terminal through an information communication means, said storage medium storing said software program and said individual identification code (see parts (a) and (d) of claim 1 above).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reeder in view of U.S. Pat. No. 6,081,785 to Oshima et al.

Reeder discloses the software program providing system according to claim 1, but does not show the limitation wherein said storage means further comprises a DVD-ROM and said individual identification code includes a BCA code recorded through a laser beam during a fabrication process of said individual identification code. However, Reeder does disclose the use of encryption to provide additional security (see page 5, lines 33-37, and page 6, line 1).

Oshima et al. show the use of the BCA to store an identification code and a cryptographic key on a DVD (see column 1, lines 36-50), so that a fee may be charged for the use of the disk (see column 4, lines 60-64). Oshima et al. further disclose that the BCA code is recorded with a laser during fabrication and can be used for security (see column 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to use a DVD-ROM for the storage means, with a BCA identification code as taught by Oshima et al.

The modification would have been obvious because one of ordinary skill in the art would have been motivated to improve security by transcribing the storage medium with an individual identification code.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Pat. No. 5,625,690 to Michel et al. and U.S. Pat. No. 6,049,789 to Frison et al. show software pay per use systems. U.S. Pat. No. 5,375,240 to Grundy shows an information distribution system. U.S. Pat. No. 5,388,211 to Hornbuckle shows a method for remote control and monitoring of software usage. U.S. Pat. No. 5,548,645 to Ananda shows a software rental system.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (703) 305-0352. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Michael J. Yigdall  
Examiner  
Art Unit 2122

MY

mjy  
August 7, 2003



JOHN CHAVIS  
PATENT EXAMINER  
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